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BRIEF FOR APPELLANT

Sir:

This is a Brief on Appeal from the Examiner's Final Rejection concerning the above-identified application.

The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; C.F.R. §1.136.

BRIEF FOR APPELLANT

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I. REAL PARTY IN INTEREST

The Real Party in Interest in this Appeal is Unilever Bestfoods, North America, Division of Conopco, Inc., a corporation of the State of New York.

II. RELATED APPEALS AND INTERFERENCES

Neither the Appellants, their legal representatives nor the Assignee are aware of any other Appeals or Interferences relating to the present Appeal.

III. STATUS OF CLAIMS

This Appeal is taken from the Final Rejection of claims 1 through 9, 11, 14 and 15, the pending claims in the application. A copy of the appealed claims is attached to this Brief as an Appendix.

IV. STATUS OF AMENDMENTS

An Amendment after the Final Rejection had been filed on March 23, 2007, but has not been entered by the Examiner for purposes of this Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention set forth in the claims on appeal is directed to a honey extender that, unexpectedly, can be used to make a honey comprising composition that has taste characteristics that are substantially the same as those of conventional honey. The claimed honey comprising composition with the honey extender of this invention has elevated levels of oligosaccharides with a higher moisture content than honey, and does not display crystallization characteristics for at least about three years at ambient temperature, and has excellent flowability properties. Further as shown in Examples 1-3 in the Specification (pp. 7-8), the honey comprising composition with the honey extender of this invention has microbiological stability indistinguishable from that of conventional honey, even with the higher moisture content. See Specification at page 2, lines 12-20.

In the Specification, the portion from page 1, line 16 to page 3, line 12 is background. The phraseology used in claim 1 may be found, for example, on pages 3-5 of the Specification as originally filed. Beginning at page 7, line 5, working examples, illustrating the unexpected results and superior properties of the composition of this invention, are put forth.

Independent Claim 1 is directed to a honey extender comprising:

a) at least about 7.0% by weight oligosaccharide;

b) at least about 60.0% by weight corn syrup having a D.E. of at least about 36 (See Specification at page 5, lines 5-6) ; and

c) water

wherein weight percent is based on total weight of the honey extender; and the honey extender is free of viscosifier and non-nutritional sweetener. See Specification at page 3, lines 13-18.

The invention of claim 1 is further defined by the dependent claims which claim, among other things, the amount of oligosaccharide.

Claim 3, dependent on claim 1, specifies that the honey extender comprises from about 65.0% to about 95.0% by weight corn syrup.

Claim 4, dependent on claim 1, specifies that the corn syrup has a D.E. from about 36 to about 48. Claim 5, dependent on claim 1, specifies that the corn syrup has a D.E. from about 40 to about 44. Claim 6, dependent on claim 1 specifies that the honey extender comprises from about 30.0% to about 40.0% by weight glucose, and from about 40.0% to about 50.0% by weight fructose. See Specification at page 5, lines 21-44. Claim 7, dependent on claim 1 specifies that the honey extender comprises less than 3.5% by weight maltose. See Specification at page 5, lines 26-27.

Claim 9, dependent on claim 1 specifies that the honey extender comprises from about 20.0% to about 25.0% by weight water. See Specification at page 6, lines 5-7.

In a second aspect, the present invention is directed to a honey composition that comprises the honey extender according to the first aspect of this invention. As claimed in Claim 11, a honey comprising composition includes:

- a) about 20.0% to about 30.0% by weight honey, based on total weight of the honey comprising composition (See Specification at page 6, lines 24-28); and
- b) honey extender comprising:
 - (i) at least about 7.0% by weight oligosaccharide, based on total weight of the honey extender;
 - (ii) at least about 60.0% by weight corn syrup having a D.E. of at least about 36, based on total weight of the honey extender; and
 - (iii) water; and

the honey extender is free of viscosifier and non-nutritional sweetener.

See Specification at page 4, lines 20-22; p. 5, lines 5-8 and 15-16.

Claim 14, dependent on claim 11 specifies that the honey comprising composition does not display sugar crystallization at ambient temperature for at least about three years. See Specification in its entirety and Example 5.

Claim 15, dependent on claim 11 specifies that the honey comprising composition has substantially the same taste as honey. Note, substantially the same taste as conventional honey means that at least one half of the panelists tasting the honey comprising composition comprising the honey extender of this invention cannot distinguish the same from conventional honey. See Specification at page 4, lines 5-8.

Moreover, the honey comprising composition of this invention not only has the taste of conventional honey, but it is approximately 200.0 % cheaper to purchase than honey. See Specification at page 2, lines 12-20.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues raised in this appeal are primarily ones of fact and of the type normally encountered in connection with a rejection made under 35 USC §103. In particular, the issues are as follows:

Claims 1, 2, 4, 5 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Topalian (U.S. Pat. No. 3,294,552) as evidenced by MMSA (Michigan Maple Syrup Association, Information Facts and Figures). According to the Examiner, Topalian discloses a shelf stable honey comprising 1-30 % honey and a honey extender which may comprise any edible, water-soluble sugar such as sucrose, dextrose, fructose or maltose, mixtures of suitable sugars, mixtures of suitable sugars with partially hydrolyzed starch such as corn syrup with a dextrose equivalent of preferably 24-60; In Example 1 of Topalian, the extender can include 57% (i.e. about 65%) corn syrup (Applicants submit that Topalian fails to disclose at least 60 % corn syrup); a preferable mixture of sugars include 5-15% maple syrup, 5-40% corn syrup, and at least 40% cane syrup. Further according to the Examiner, as evidences by MMSA, maple syrup solids comprise 100 % oligosaccharides, thus the honey extender, as taught by Topalian includes about 3-15% oligosaccharides.

Claims 1, 3-9, 11, 14, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Topalian (U.S. Pat. No. 3,294,552) in view of Wikipedia.com Honey (<http://en.wikipedia.org/wiki/Honey>). According to the Examiner, Topalian discloses 1-30 % honey and a honey extender which may comprise any edible, water-soluble sugar such as sucrose, dextrose, fructose or maltose, mixtures of suitable sugars, mixtures of suitable sugars with partially hydrolyzed starch such as corn syrup with a dextrose equivalent of preferably 24-60; In Example 1 of Topalian the extender can include 57% (i.e. about 65%) corn syrup (Applicants submit that Topalian fails to disclose at least 60 % corn syrup); a preferable mixture of sugars include 5-15% maple syrup, 5-40% corn

syrup, and at least 40% cane syrup; about 30-40 % glucose and about 40-50 % fructose as recited in claim 6; less than 3.5 % maltose as recited in claims 7 and 8; about 20-25 % water as recited in Claim 9; and the properties of the honey with the extender as recited in claims 14 and 15.; However, it would be obvious to vary the amount of corn syrup and to achieve the parameters of claims 14 and 15; Regarding the properties of the honey with the extender as recited in claims 14 and 15, because the honey composition as taught by Topalian is similar to the instantly claimed honey composition, one of skill in the art would expect the honey composition as taught by Topalian to possess the similar characteristics as the instantly claimed honey composition.

Appellants respectfully submit that claim 3, specifying from about 65.0% to about 95.0% by weight corn syrup in the honey extender composition is separately patentable.

Appellants respectfully submit that claim 9, specifying the water content in the honey extender composition is separately patentable.

Appellants respectfully submit that claims 14 and 15, specifying crystallization and taste properties, are separately patentable.

VII. ARGUMENT

None of the cited references alone or in combination describes a honey comprising composition comprising a honey extender wherein the honey comprising composition has the taste and microbiological stability of conventional honey, and does not crystallize for at least about three years at ambient temperature. The present invention uses oligosaccharides and sweeteners that are fully metabolizable in preparing a honey extender that is indistinguishable from honey in taste, thickness and flow characteristics but contains more water and exhibits no sugar crystallization over an extended period of time. The present invention achieves unexpected results, even in the absence of viscosifier and non-nutritional sweeteners, for at least the following reasons.

With respect to the rejection of Claims 1, 2, 4, 5 and 11 under 35 U.S.C. 103(a) as being unpatentable over Topalian (U.S. Pat. No. 3,294,552) as evidenced by MMSA (Michigan Maple Syrup Association, Information Facts and Figures), MMSA fails to disclose corn syrup which is required by the independent claims in an amount of at least about 60 %. Maple syrup is not acceptable for use in the present invention as honey taste is the aim of the honey extender and composition of the present invention. MMSA fails to cure the deficiencies of Topalian and a *prima facie* case of obviousness has not been made.

With respect to the rejection of Claims 1, 3-9, 11, 14, and 15 under 35 U.S.C. 103(a) as being unpatentable over Topalian (U.S. Pat. No. 3,294,552) in view of Wikipedia.com Honey <http://en.wikipedia.org/wiki/Honey>), one skilled in the art would expect that increasing the water content of the honey composition via the addition of the claimed extender would reduce the microbiological stability of the composition and would lead away from distinctive honey flavor. Topalian fails to disclose water at 20-25 % and Wikipedia confirms that natural honey is microbiologically stable due to its moisture content being too low, i.e., under 18 (see p. 1, Para. 3). The microbiological

stability of the claimed invention is indistinguishable from honey, while the water content of the overall honey comprising composition, accounting for water content in the Honey and the water content in the honey extender, is greater than 20 %.

Appellants respectfully submit that claim 3 is separately patentable. Topalan fails to disclose more than 57 % corn syrup. How can Wikipedia be a suitable prior art reference for claim 3 which requires about 65.0% to about 95.0% corn syrup, when it states that "honey has a distinctive flavor" which is preferred over sugar and other sweeteners?

Appellants respectfully submit that claim 9, specifying the water content in the honey extender composition is separately patentable. Further to the statements above, Topalan does not add water. Wikipedia discloses a water content of 17% to under 18% (see p. 1 and p. 3).

Appellants respectfully submit that claim 14, specifying crystallization properties, is separately patentable. One skilled in the art would expect some crystallization to occur in the product particularly after prolonged storage under ambient conditions. Yet, to the contrary, the claimed honey composition containing the honey extender showed no crystallization after several years of storage. As Topalan is silent regarding crystallization, and Wikipedia teaches a water content below 18%, one skilled in the art would expect that there would be crystallization, contrary to the present claim 14.

Appellants respectfully submit that claim 15, specifying taste properties, is separately patentable. One skilled in the art would expect that the honey flavor would be significantly reduced via dilution with the claimed honey extender. Moreover, Example 1 of Topalan on which the Examiner relies specifies a honey-maple flavor (see Col. 2, lines 48-49), which is different from what the present invention achieves. Wikipedia confirms that "honey has a distinctive flavor" which is preferred over sugar and other sweeteners. In contrast, the taste of the inventive honey composition containing the honey extender was not only indistinguishable from honey but was

selected by some consumers as honey when asked to pick out the composition that they thought was real honey.

Appellants respectfully submit that claims 14 and 15 are separately patentable. The Examiner's rejection is based on "similar" compositions, whereas the In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) case cited by the Examiner requires that the products be the same. Accordingly, there is no basis for one skilled in the art to expect similar or the same properties, the Examiner's contention notwithstanding. Accordingly, claims 14 and 15 are separately patentable, among other reasons, because a *prima facie* case of obviousness has not been made out and because, despite the lack of a proper rejection and the burden remaining with the Examiner, evidence of unexpected results has been submitted in the Specification.

Example 3 on page 8 of the Specification demonstrates objective evidence of unexpected results in this regard. The honey comprising compositions prepared according to Examples 1 and 2 of the present invention were microbiologically stable, had substantially the same taste as conventional honey and displayed no sugar crystallization, even in the cap region, after about 4.5 years of storage. In contrast, as shown in Example 4, conventional honey crystallized after about one year. Example 5 demonstrates a unanimous panel as to the taste of the composition of Example 3 being indistinguishable from that of conventional honey.

Clearly, Claims 9, 14 and 15 are separately patentable.

Appellants respectfully submit that all claims are in condition for allowance.

CONCLUSION

In view of the above, Appellants respectfully submit that a proper rejection under 35 U.S.C. 103 has not been made and the application is in condition to be allowed to issue. Accordingly, reversal of the Final Rejection by the Honorable Board is appropriate and is courteously solicited.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. (previously presented) A honey extender comprising:
 - a) at least about 7.0% by weight oligosaccharide;
 - b) at least about 60.0% by weight corn syrup having a D.E. of at least about 36; and
 - c) waterwherein weight percent is based on total weight of the honey extender; and wherein the honey extender is free of viscosifier and non-nutritional sweetener.
2. (original) The honey extender according to claim 1 wherein the honey extender comprises from about 7.5 to about 18.0% by weight oligosaccharide.
3. (original) The honey extender according to claim 1 wherein the honey extender comprises from about 65.0% to about 95.0% by weight corn syrup.
4. (original) The honey extender according to claim 1 wherein the corn syrup has a D.E. from about 36 to about 48.
5. (original) The honey extender according to claim 1 wherein the corn syrup has a D.E. from about 40 to about 44.
6. (original) The honey extender according to claim 1 wherein the honey extender comprises from about 30.0% to about 40.0% by weight glucose, and from about 40.0% to about 50.0% by weight fructose.
7. (original) The honey extender according to claim 1 wherein the honey extender comprises less than 3.5% by weight maltose.
8. (original) The honey extender according to claim 1 wherein the honey extender comprises from about 1.75% to about 2.25% by weight maltose.

9. (original) The honey extender according to claim 1 wherein the honey extender is from about 20.0% to about 25.0% by weight water.

10. (canceled)

11. (previously presented) A honey comprising composition comprising:

a) about 20.0% to about 30.0% by weight honey, based on total weight of the honey comprising composition; and

b) honey extender comprising:

(i) at least about 7.0% by weight oligosaccharide, based on total weight of the honey extender;

(ii) at least about 60.0% by weight corn syrup having a D.E. of at least about 36, based on total weight of the honey extender; and

(iii) water; and

wherein the honey extender is free of viscosifier and non-nutritional sweetener.

12-13. (canceled)

14. (original) The honey comprising composition according to claim 11 wherein the composition does not display sugar crystallization at ambient temperature for at least about three years.

15. (original) The honey comprising composition according to claim 14 wherein the composition has substantially the same taste as honey.

IX. EVIDENCE APPENDIX

No additional evidence had been submitted.

X. RELATED PROCEEDINGS APPENDIX

Neither the Appellants, their legal representatives nor the Assignee are aware of any proceedings relating to the present Appeal.